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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,376	01/05/2001	Takuji Yoshihiro	0505-0738P	3525

2292 7590 05/13/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,376

Applicant(s)

YOSHIHIRO, TAKUJI

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 1, 2, 4-11, 14-17, and 20; cancelled claims 12, 13, 18, and 19; and added claims 21-24. Claims 1-11, 14-17, and 20-24 have been examined.

Drawings

2. The drawings were received on 18 February 2005. These drawings are acceptable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "and/or" renders each claim indefinite because it is unclear whether the limitations preceding and following the phrase are part of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 9-11, 14-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,606,609 to Houser et al.

As per claims 1-3, and 20, Houser discloses a document verification method in which security information (a reference characteristic) derived from a document digest is embedded into a document, and later extracted and compared to a calculated document digest (a comparison subject characteristic value) to verify (the determining means) the document (see abstract).

The computer at which Houser embeds the security information constitutes a managed computer system (the second computer). The document may then be transmitted to a recipient on another computer, the "management computer system" (the first computer) (see column 7, lines 61-65).

As per claims 4 and 14-17, the security information may be a hash value (see column 4, lines 20-34). If the document is graphical (i.e. a drawing), a watermark may be embedded (see column 4, lines 52-60). All copies show the same document, so they are all drawing data.

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As per claims 9-11, the embedded information may be created using a public key encryption algorithm (see column 4, lines 3-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,606,609 to Houser et al. as applied to claims 1 and 20 further in view of U.S. Patent Application Publication No. 2002/0019777 to Schwab et al.

The invention of Houser is not disclosed as being used to represent the three-dimensional geometry of a manufactured product.

Schwab discloses a merchandise return system wherein physical descriptions (i.e. the geometry) of a manufactured product is used as a parameter in a merchandise return (see paragraph 12) and suggests that this allows a user to inspect and authorize a return for credit at a third party location (see paragraph 6).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Houser by using it in a return

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system, as disclosed by Schwab, as this allows a user to inspect and authorize a return for credit at a third party location.

It is noted that Applicant may be able to overcome this stated rejection by claiming the process for acquiring the three-dimensional geometry parameters in greater detail.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,246,778 to Moore in view of U.S. Patent No. 5,606,609 to Houser et al. further in view of U.S. Patent No. 6,052,669 to Smith et al.

Moore discloses an authentication system that includes a scenario wherein authentication information is used to authenticate a piece of merchandise to either a supplier or a customer (see claim 9).

Moore does not disclose the exact algorithm by which the authentication is performed.

Houser discloses the algorithm of claims 2 and 3, as discussed above, and further suggests that this gives a system that is user-friendly and deters forgery and alterations (see column 3, lines 41-45).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Moore by using the technique disclosed by Houser, in order to yield a system that is user-friendly and deters forgery and alterations.

Moore and Houser also do not disclose the submission of an order based upon an electronic drawing.

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Smith discloses a system where a CAD system (which generates electronic drawings) is used by a customer to generate an order to be submitted (see column 5, lines 36-53), and suggests that this is superior to the task being performed via a sales representative, which can take many sales calls and design iterations (see column 2, lines 9-40).

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Moore and Houser for a CAD-based ordering system, as disclosed by Smith, as this is superior to the task being performed via a sales representative, which can take many sales calls and design iterations.

Response to Arguments

7. Applicant's arguments, see Remarks, filed 18 February 2005, with respect to the rejections under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive with respect to the rejection of claim 2 et al. for being incomplete and the second previously stated grounds for claim 7. Claims 2, 7, and 8 remain indefinite, however, due to the continued use of the term "and/or," which renders the claims indefinite.

8. Applicant's arguments filed 18 February 2005 have been fully considered but they are not persuasive. The two computer at either end of the network described by Houser could each be described as either "managed" or

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"management" computers, and therefore the amendment has not overcome some of the previous rejections. Additional art has been applied in view of Applicant's amendments for the remaining claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone

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number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GREGORY MORSE
SUPERVISOR
TECHNICAL CENTER 1100

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MEH *mf*

May 10, 2005